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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,330	06/09/2006	Hitoshi Sumiya	070456-0115	4934
20277 7590 11/26/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EXAMINER HAN, SHENG	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 11/26/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,330	Applicant(s) SUMIYA, HITOSHI	
	Examiner SHENG HAN	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 and 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/9/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Claims 1-5 and 12-16 in the reply filed on November 6, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starchenko (WO 03/086971) and further in view of Swain (2005/0110024).

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Starchenko teaches the synthesis of a superhard diamond material using boron (preferred process and abstract), for use in tools. The reference does not, however, specify how much boron is used.

Swain teaches a boron-doped nanocrystalline diamond (title, abstract). The diamond particles are disclosed to be between 10-16nm in size and the boron concentration is between 1 to 20ppm (para. 0034). Although Swain does not specifically teach that the average particle size is below 50nm, however, it is inherent that since the particle range is all below 50nm, that the average particle size would be below 50nm. Moreover, it would have been obvious to one of ordinary skill in the art at the time of the invention to put from 1-20ppm of boron in the diamond composition, as taught by Swain, with the diamond particles for use in tools, as taught by Starchenko because boron enables diamonds to be electrically conductive, which would make it more effective in certain tools.

Regarding Claim 2, Swain teaches an electrical resistance of 0.2 ohm cm (para. 0031). This is less than 10 ohm cm.

Regarding Claim 3, since Swain teaches a particle range of between 10-16nm (para. 0034), the maximum particle range is less than 50nm and the average particle diameter is less than 30nm.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starchenko (WO 03/086971) in view of Swain (2005/0110024) as applied to Claim 1, and further in view of Akaishi (WO2004/046062). Please see the corresponding US version (2006/0115408).

Starchenko and Swain teach diamonds with a specific particle range, boron composition and resistance, but neither of them teach a hardness level of over 80-110 GPa.

Akaishi teaches a high hardness diamond having a maximum size of 100nm or less (abstract). The diamond is conductive and therefore has a low resistivity (para. 0051). Regarding the hardness, Akaishi teaches that the hardness is over 80 GPa (para. 0048, 100 GPa) and over 110 GPa (para. 0050, 115 GPa).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the superhard diamond with a hardness of over 80 and 110 GPa, as taught by Akaishi, for use in tools, such as drills because these tools require a high strength and resistance under a lot of pressure.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meidensha (2001/21521).

Meidensha teaches a diamond with particle diameter of 1-10 micrometers (1,000-10,000 nm) (para. 0016) with a boron amount of 100,000ppm (para. 0025).

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meidensha as applied to Claim 12, and further in view of Swain (2005/0110024).

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Meidensha teaches a diamond particle with a diameter of 1-20 microns and a boron amount of 100,000ppm, but does not teaches a particle size of less than 1,000nm.

Swain teaches a boron-doped nanocrystalline diamond (title, abstract). Swain further teaches that the resistance is 0.2 Ohm cm (para. 0031). Boron enhances conductivity which there by decreases resistance. Therefore, although the amount of boron in the claim is more than the amount described in Swain, it would be inherent that the conductivity would be less than 0.2 ohm cm.

Regarding Claim 14, the diamond particles disclosed are between 10-16nm in size (para. 0034). Although Swain does not specifically teach that the average particle size is below 500nm, however, it is inherent that since the particle range is all below 50nm, that the average particle size would be below 500nm.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meidensha and Swain as applied to claims 12 and 13 above, and further in view of Akaishi.

Meidensha and Swain teach a diamond with a particle size of 10,000nm and 1,000nm with a boron composition of 100,000ppm and 1 to 20ppm (para. 0034).

Akaishi teaches a high hardness diamond having a maximum size of 100nm or less (abstract). The diamond is conductive and therefore has a low resistivity (para. 0051). Regarding the hardness, Akaishi teaches that the hardness is over 80 GPa (para. 0048, 100 GPa) and over 110 GPa (para. 0050, 115 GPa).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a diamond with a hardness of over 80 and 110 GPa, as taught by Akaishi, with the diamond composition, as taught by Meidensha and Swain for use in tools, such as drills because these tools require a high strength and resistance under a lot of pressure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHENG HAN whose telephone number is (571)270-5823. The examiner can normally be reached on Monday-Thursday, 7:30-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melvin Curtis Mayes can be reached on 571-272-1234. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sheng Han
Examiner
Art Unit 1973

SH
November 19, 2008

/Melvin Curtis Mayes/
Supervisory Patent Examiner, Art Unit 1793